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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,743	10/05/2001	John A Flygare	018781-001823US	5345

7590 09/09/2005

BANNER & WITCOFF  
1001 G STREET, N.W.  
WASHINGTON, DC 20001

EXAMINER
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RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Mc*

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/972,743

Applicant(s)

FLYGARE ET AL.

Examiner

Deepak Rao

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1624

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 22 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

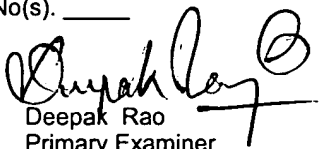
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Deepak Rao  
Primary Examiner  
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**ADVISORY ACTION**

The amendment filed August 22, 2005 under 37 CFR 1.116 in reply to the final action has been acknowledged. The amendment in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

The newly presented claims do not overcome the rejection based on CAPLUS Abstract 116:214490, for the reasons of record. Applicant relies on the amendment and indicates that the newly added claims 112-128 correspond to the claims that were indicated allowable in the previous office action. However, this is not deemed to be the case. For example, new claims 114, 120 and 126 are indicated as claims that correspond with previously presented claims 41, 100 and 108. However, these claims continue to recite the limitation 'R<sup>1</sup> and R<sup>2</sup> of the -NR<sup>1</sup>R<sup>2</sup> may be connected by a linking group E to give a substituent of the formula  $\begin{array}{c} \text{R}^1 - \text{E} \\ | \quad | \\ \text{N} - \text{R}^2 \end{array}$  wherein E is a bond, alkylene or heteroalkylene' (see each of the claims). The previously presented claims 41, 100 and 108 on the other hand did not contain the above limitation that 'R<sup>1</sup> and R<sup>2</sup> together may be connected by linking group E'. (Previously presented claims 41 and 100 are provided below for convenience):

**Claim 41 (original):** The composition of claim 2, wherein R<sup>1</sup> is an optionally substituted (C2-C10)alkyl or optionally substituted (C2-C6)heteroalkyl.

**Claim 100 (previously presented)** A compound of claim 61, wherein R<sup>1</sup> is an optionally substituted (C2-C10)alkyl or optionally substituted (C2-C6)heteroalkyl.

The base claim from which claim 41 depends from provides individual definitions to R<sup>2</sup> and R<sup>1</sup> and further alternatively recites the limitation that 'R<sup>1</sup> and R<sup>2</sup> of the -NR<sup>1</sup>R<sup>2</sup> may be connected by a linking group E to give a substituent of the formula  $\begin{array}{c} \text{R}^1 - \text{E} \\ | \quad | \\ \text{N} - \text{R}^2 \end{array}$  wherein E is a bond,

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alkylene or heteroalkylene'. Since the dependent claim 41 limited the definition of  $R^1$ , and did not include the limitation that ' $R^1$  and  $R^2$  are connected by the linking group E', it was indicated as not being anticipated by the reference. The current amendment continues contain claims that read on reference disclosed compound, and therefore is not sufficient to overcome the rejection.

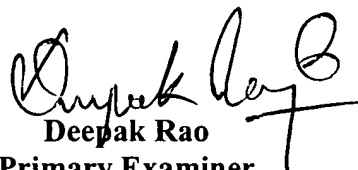
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Acting-SPE of 1624, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Deepak Rao  
Primary Examiner  
Art Unit 1624

September 7, 2005